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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,713	11/29/2001	Glen Friedman	007287.00014	4318
22907 7590 11/28/2007 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051			EXAMINER BAUTISTA, XIOMARA L	
			ART UNIT 2179	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/997,713

Applicant(s)

FRIEDMAN ET AL.

Examiner

X. L. Bautista

Art Unit

2179

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-9, 12-18 and 20 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 8, 9, 12-17 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 8 and 13 recite a machine-readable medium including instructions, which are defined in the specification as code that may be represented by carrier-wave signals, infrared signals, etc.
4. Claims that recite nothing but the physical characteristics of a form of energy, such as a frequency, voltage, or the strength of a magnetic field, define energy or magnetism, per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at 112-14. Moreover, it does not appear that a claim reciting a signal encoded with functional descriptive material falls within any of the categories of patentable subject matter set forth in § 101. First, a claimed signal is clearly not a "process" under § 101 because it is not a series of steps. The other three

§ 101 classes of machine, compositions of matter and manufactures "relate to structural entities and can be grouped as 'product' claims in order to contrast them with process claims." 1 D. Chisum, Patents § 1.02 (1994). The three product classes have traditionally required physical structure or material.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 1-5 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gupta et al* (US 6,546,405 B2), *Boreczky et al* (US 6,366,296 B1) and *Bennett et al* (US 5,884,256).**

Claim 1:

Gupta discloses a *method comprising automatically identifying a plurality of desired portions of a multimedia presentation by user's equipment*. Gupta teaches an annotation file that is created for a multimedia presentation; Gupta's *annotating temporally-dimensioned multimedia content* is achieved when *a human viewing temporally-dimensioned content* will annotate, comment upon, and augment the

multimedia document (abstract; col. 2, lines 13-64). Thus, *identifying at least one desired portion* occurs (col. 2, lines 13-35). The resulting *annotation entry 300* records *at least one pointer corresponding to the at least one desired portion* (col. 10, line 65- col. 11, line 35), in an *annotation collection 420* (the claimed annotation file; see figs. 3 and 4).

Gupta discloses *using the at least one pointer for automatically presenting only the one or more portions of the multimedia presentation*. Gupta teaches a multimedia document player (col. 2, lines 36-48) that is one in which a user can select a temporal annotation from a list, at which point the multimedia document player immediately proceeds to the presentation of the multimedia document at the particular relative time (col. 2, lines 48-64). In this immediate procession, Gupta is *automatically* performing the function of going to the particular relative time, showing only what is annotated at that time from programming playback, and eliminating any other portions of the multimedia presentation than those desired.

Gupta discloses a database containing a *first pointer corresponding to a first desired portion* and a *second pointer corresponding to a second desired portion*, both *pointers* being separated in the presentation by an intervening portion, and using the *pointers to automatically present only the plurality of desired portions of the multimedia presentation without presenting any other portion*. Gupta teaches temporal annotations that provide a mechanism by which the user can pinpoint a

particular point (create a pointer) in the content of a multimedia document and later immediately view the content at that particular point (col. 17, lines 16-38), wherein the system will only display the content that is associated with the different marked points in the content of the multimedia presentation.

Gupta discloses *automatically identifying at least one desired portion of a multimedia presentation*, which is accomplished by user's equipment. Gupta's *annotating* is disclosed as requiring a human's input to determine the *desired portion*, and Gupta does not explicitly teach that such action is *automatically performed by user's equipment*. Also in claim 1, *automatically presenting only the one or more portions...without displaying the annotations* does not appear to be an explicit part of Gupta, where an ongoing display will typically present the annotations with the material retrieved. However, both of these shortcomings are remedied in **Boreczky**, where automatic detection of desirable portions of a *multimedia presentation* are used in a *media browser using multimodal analysis*, with a resulting display of only playback content, as per playback region of Boreczky that is shown without annotating content as well.

In Boreczky, features in a media file are preferably automatically time-wise evaluated in the media file (abstract; col. 1, lines 60-67; col. 2, lines 1-7). In the user computing environment, Boreczky shows in fig. 13, a mapping module 115 can automatically generate metadata values for all of the selectable features (col. 11,

lines 52-63), so that *automatically identifying* is accomplished *by user's equipment*. Further, in Boreczky, the closest to an illustration of the actual annotations are timeline indicators, but these are not part of the media playback window. Of course, a similar line of reasoning might also be advanced for Gupta, where the media display is not directly incorporated with the annotations that might appear at another location. The media playback regions in such systems as this provide a non-annotation containing presentation. It would have been obvious to a person having ordinary skill in the art at the time of applicant's invention that the annotation collection developed by Gupta for multimedia by obtained by automatically considering the media as per Boreczky, and then presented in an ordinary media display region with no annotations supplied there, so as to alleviate the need for Gupta's human input and make a more substantial set of features available for user access, with the overall result of producing a more-desirable uncluttered view of the media. Motivation lies at least in Gupta, where the goal is to build as comprehensive a set of annotations as is possible, and this would be directly facilitated with the Boreczky teachings of machine-generated metadata.

Boreczky discloses automatically displaying the plurality of desired portions *without user interaction*. Boreczky explains that the system provides feature information to the user based on automatically identified features which eliminates the need for a user to manually mark portions of the media file for later retrieval;

the system automatically identifies, generates and provides feature information to the user (col. 2, lines 1-7, 13-17; col. 3, lines 35-45; col. 5, lines 64-67; col. 6, lines 1-11; col. 11, lines 52-60).

Gupta/Boreczky does not specifically teach automatically displaying the plurality of desired portions *without user interaction*. However, **Bennett** discloses a system for providing real-time use and manipulation of transcribed testimony by attorneys, judges, court reporters, witnesses and clients (abstract; col. 1, lines 23-28). Bennett teaches that a user is enabled to select portions of text and associate supplemental information with the text; and then, during review, the user can sequentially view the selected portions of the text by skipping unselected portions of the text (abstract; col. 23, lines 21-40). Bennett also teaches pointers that are associated with recorded information (col. 13, lines 30-56; col. 18, lines 25-64). Bennett teaches automatically providing desired (marked) portions without user interaction (col. 25, lines 37-667; col. 26, lines 1-33). Thus, it would have been obvious to one ordinarily skilled in the art at the time of invention to modify Gupta/Boreczky to include Bennett's teaching of automatically providing a user with marked information while reviewing a presentation because the user is provided with content of interest on-the-fly while reviewing a presentation, being information that has been marked by the user or by the system, or additional information that is associated with portions of the presentation, which saves the user time by not

having to manually search for such content.

Claim 2:

See claim 1. Gupta's multimedia document player is capable of creating and playing the recorded program file, so that only the at least one desired portion appears, to the exclusion of others.

Claims 3, 4, 14 and 15:

The application of a predetermined set of criteria in identifying at least one desired portion (claims 3 and 14) is seen in Gupta, where the user can select temporal annotations which satisfy various criteria for inclusion in the display of the multimedia document (col. 2, lines 48-54), these being based upon a preference of an individual viewer (claims 4 and 15), such as a particular date. Boreczky echoes this capability of implementing user desire, when the user preferably selects at least one feature of the media file using the media feature selection 4 (col. 11, lines 34-51).

Claims 5 and 16:

See claim 1. The annotation file that further contains information related to the at least one desired portion reads upon the annotation in Gupta holding additional information, relative to the multimedia document, as in the inclusion of user authored content in content field 310 of a Gupta temporal annotation entry 30 (col. 4, lines 52-63).

Claim 13:

See claim 1. The recorded program file reads upon Gupta's storage of the original multimedia content 140, which can alternatively be a motion video or audio file (col. 4, lines 28-51). In handling the collection 420, Gupta uses an annotation measurement software so that a display device displays only the at least one desired portion. Gupta does not teach an annotation file that is automatically created however, Boreczky provides such a teaching, as noted above.

Claim 17:

See claim 1. The overall collection 420 in Gupta will have information related to a portion other than the at least one desired portion, since annotations to portions other than those satisfying criteria are included.

7. Claims 6-9, 12, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Gupta/Boreczky/Bennett* and *Kelly et al* (US 5,907,322).

Claim 6:

See claim 1. Bennett teaches that a user's terminal can be located off-site and other terminals may be connected to the network, wherein all the users connected to the network can receive and view the same content at remote locations (abstract). Gupta/Boreczky/Bennett does not explicitly teach broadcasting an event to a first location and simultaneously identifying a desired portion of the event at a

location remote from the first location. Gupta does not contain explicit teachings of such a mode of transmission, being more concerned with what happens at the site of the multimedia document player itself, and a similar problem exists with the player environment of Boreczky. However, Kelly discloses a television event marking system that allows for bookmarking viewer selected TV broadcast events (abstract), and storing a set of event-identifier data associated with the set of selected broadcast events (col. 1, lines 54-67). Kelly further teaches that an activity table of viewer selection information is transmitted to an on-line database (col. 1, lines 54-67), this being at a location remote from the viewer site. It would have been obvious to one having ordinary skill in the art at the time of invention to employ Boreczky's permitting of an annotation file to be simultaneously performed relative to the broadcasting, where such broadcasting involves, as in Kelly, transmitting to a viewing system the annotation file as a transmission that is distinct from the broadcast of the event for selective playback as per Gupta, so as to increase the range of options in obtaining and accessing a variety of different annotations for content being seen.

Claim 7:

See claim 6. Kelly's bookmarking follows the selected broadcast event, and is thus the annotation file that is transmitted subsequent to the event.

Claim 8:

See claim 2. Gupta teaches creating an annotation file used in rendering only one or more desired portions, and without distracting metadata also in the display region, as seen at least in Boreczky. The first transmission medium and the second transmission medium are suggested by Kelly, where annotating information is sourced at a separate location from a multimedia viewing system, as in Kelly's database origination of user-specific information.

Claim 9:

See claim 2. Gupta teaches multimedia being stored as a recorded program file.

Claims 12 and 20:

See claims 3 and 5. Gupta teaches an annotation file containing information related to at least one portion of a multimedia presentation.

Claim 18:

See claim 6. Gupta's author's creation of entries in the collection 420 reads upon *an editor to create an annotation file*. The use of a first and second transmission medium for the presentation and the annotation file is suggested by an extension to Kelly's broadcast environment, when receiving the additional Gupta annotations.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to X. L. Bautista whose telephone number is (571) 272-4132. The examiner can normally be reached on Monday-Thursday 8:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (571) 272-4847. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



X. L. BAUTISTA
PRIMARY EXAMINER

xlh
November 21, 2007